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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,184	11/13/2003	Gerald A. Case	JCA1-H23	9388
7590	03/15/2005		EXAMINER	
Karl M. Steins Steins & Associates Suite 120 2333 Camino del Rio South San Diego, CA 92108			TALBOT, MICHAEL	
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 03/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,184

Applicant(s)

CASE, GERALD A.

Examiner

Michael W Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant is advised that should claims 1 and/or 2 be found allowable, claims 14 and/or 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Specification

1. The disclosure is objected to because of the following informalities:

Refer to page 7, lines 8 and 9, character reference "head 26" should be changed to --head 14--.

Refer to page 7, line 19, character reference "face 34" should be changed to --face 26--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-13,16,18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2 and 18, it is unclear as to the claimed limitation defined by the phrase "said punch outer diameter being greater than said head outer diameter". The specification and the figures do not support the claimed limitation. In fact the specification and figures support the direct opposite, i.e. that the punch outer diameter is smaller than the mandrel head diameter. Refer to page 4, lines 7-9 of the specification and figures 2,3,6A and

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6B. For examination purposes, it has been best understood that the mandrel head diameter is greater than the punch outer diameter.

Regarding claims 6 and 16, it is unclear as to the claimed limitation defined by the phrase "said head extending from said head end". For examination purposes, it has been best understood that the phrase should have read "said shaft extending from said head end".

Regarding claim 9, it is unclear as to the claimed limitation defined by the phrase "placing said punch a said sheet".

Regarding claim 20, it claims dependency upon itself. Therefore it is unclear as to the subject matter and specific limitation thereof. For examination purposes, claim 20 has been evaluated as if it was depending from claim 14, and should be amended as such.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,9,14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser '023 in view of Bingham et al. '392. Kaiser '023 shows in Figure 1 a tool assembly comprising a mandrel (11) having an elongated shaft end (10) and a head end (15) defining an outer diameter and a face, a cutting tool (17) having a base end and a cutting end terminating in at least one tip (Fig. 1) and an attachment means for attaching the cutting tool to the mandrel (col. 1, lines 65-67). Kaiser '023 further shows the cutting tool being generally cylindrical in shape (Fig. 1) and having a diameter less than the mandrel head diameter (Fig. 2). Kaiser '023 lacks the cutting tool being a punch tool. Bingham et al. '392 shows a punch tool (10) for use with sheet metal (abstract) having a base end (22) and a cutting end (20), a pair of opposing

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trough portions (28,30), a pair of tips (54,56) and a central threaded hole (16,18) for attachment to a tool holder. In view of this teaching of Bingham et al. '392, it is considered to have been obvious to replace the cutting tool of Kasier '023 with another well-known cutting tool shown in Bingham et al. '392 to provide the desired machining.

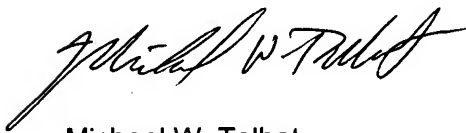
Claims 1-4,9-11,14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser '023 in view of McCutcheon '394. Kaiser '023 lacks the cutting tool being a punch tool having a pair of opposing arcuate portions and a pair of tips in alternating space relation with each other. McCutcheon '394 shows in Figure 1 a round punch tool (10) with a pair of opposing arcuate portions (17) with a pair of tips (11) in alternating space relation with each other. In view of this teaching of McCutcheon '394, it is considered to have been obvious to replace the cutting tool of Kasier '023 with another well-known cutting tool shown in McCutcheon '394 to provide the desired machining.

Claims 5-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser '023 in view of McCutcheon '394, and further in view of Morse '310. Kaiser '023 in view of McCutcheon '394 lacks the attachment means being a threaded bolt. Morse '310 shows in Figure 7 a threaded bolt (5) for attaching the cutting tool to the body (col. 3, lines 40-49). In view of this teaching of Morse '310, it is considered to have been obvious to replace the attachment means of Kasier '023 in view of McCutcheon '394 with another well-known attachment means shown in Morse '310 to provide the desired securement between the cutting tool and the mandrel body.

4. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Derris Banks, may be reached at 571-272-4419.

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In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot
Examiner
Art Unit 3722



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